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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/802,472

02/18/1997

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09/26/2007

EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
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3721

MAIL DATE	DELIVERY MODE
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09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

08/802,472

Applicant(s)

KORMANIK, CHARLES

Examiner

John Sipos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,8-15 and 17-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5,8-15 and 17-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

MISCELLANEOUS

The relationship of claims 32-48, which are stated as being “previously presented” and the claims acted on in previous actions as well as the Board of Appeals decisions, is not clear. It is requested that applicant clarify this relationship.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21,22,27,28-30,31 and 58 are rejected under **35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27,28,29 and 58 are multiple dependent claims that depend on cancelled claim 16.

Claims 21,22,28-30 are indefinite in that it is unclear what is being claimed. All the claims recite the package separately from the articles. The independent claims on which the above claims depend recite only a step of “constructing...a package” and none of the claims recite a step of “constructing an article” as the above dependent claims do. Therefore, there is no proper antecedence for the later step in the independent claims.

The subject matter of claim 31 is already present in claim 5 on which the claim depends.

Claims 5,8-15,17-24 and 27-58 are rejected under **35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention as per the Decision of the Board of Appeals of August 17, 2006 (see page 21).

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. ' 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Rejection based on Kirkland (6,006,945)

Claims 5,17,21,22,31,34,35,37,39,40,42-51,55 and 58 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Kirkland (6,006,945). The patent to Kirkland

discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see column 4, line 23 et seq and the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include balls, clothing, cleaning items and personal hygiene products (see column 5, line 44 et seq). The step of folding the article is inherent in the Kirkland process and is read on the step of reducing a piece of clothing to the size of the package.

Regarding claims 21 and 22, articles like clothing comprise one or two flaps that form openings, e.g. sleeves or hosiery.

Regarding claims 35,40,42 and 51, Kirkland discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

Regarding claims 45,46 and 48, the claimed lips are read on the edge portions of the separable parts of the package of Kirkland.

Regarding claim 58, Kirkland discloses the article being a first aid item.

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27/5-29/5,30,38 and 41 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Kirkland (6,006,945). Since Kirkland teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kirkland, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

Rejection based on Kaufman (5,813,538)

Claims 5,17,18,21,22,31,34,35,37,39,40,42-51 and 55 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Kaufman (5,813,538). The patent to Kaufman discloses a method for making a combination of a package and article that comprises constructing a plastic package having a recognizable shape that is different from the article to be placed in it, the package comprises of totally separable parts (see the figures), locating an article within the package and marketing the combination. Examples of articles that can be placed in the package include t-shirts, towels etc (see column 1, line 17 et seq). The step of folding the article is inherent in the Kaufman process and is read on the step of reducing a piece of clothing to the size of the package.

Regarding claim 18, Kaufman discloses in column5, line 43 et seq that combining of two packages in one outer package.

Regarding claims 21 and 22, articles like clothing comprise one or two flaps that form openings, e.g. sleeves.

Regarding claims 35,40,42 and 51 and their dependent claims, Kaufman discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

Regarding claims 45,46 and 48, the claimed lips are read on the edge portions of the seperable parts of the package of Kaufman.

Claims 19-20,23 27/5-29/5,30,38,41 and 58 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Kaufman (5,813,538).

Regarding claims 19,20 and 23, combining of two packages containing different articles in one outer package is well known in the art and the Examiner takes Official notice that it is well known in the packaging art. Packing two different articles are well known in kit form to provide the consumer with one pack. Similarly, the use of a means for attaching a package to another article (claim 23) is well known in the art and Official notice is taken and it would have been obvious to one skilled in the art to provide such means to the packages of Kaufman.

Regarding the other claims, Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Kaufman, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

Claims 8-15,24-26,27/8+, 28/8+,29/8+,36 and 52-57 are rejected under **35 U.S.C. '**

103(a) as being unpatentable over the patent to Kaufman (5,813,538) in view of Gossard (3,624,939). The patent to Kaufman shows various embodiments and shapes of packages having separable parts but it doesn't show package shaped as balls. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball and soccer ball. It would have been obvious to one skilled in the art to shape the packages of Kaufman in any desired shape including balls as shown by Gossard. The modification of Kaufman by forming the package with a ball shape as shown by Gossard would have been obvious because the use of one

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known and equivalent package shape for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. Since Kaufman teaches the placing of clothing within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package.

Rejection based on Forrest (1,800,990) and Francis (D346185)

Claims 32-35,40,42 and 51 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Forrest (1,800,990) or Francis (D346185). Each of these patents discloses a method for making a combination of a package and article that comprises constructing a package as a replica of a recognizable icon having a shape that is different from the article to be placed in it with the package shape conveying information relative a sport, the and locating an article within the package. Both packages and articles are used in environments which the shape of the package indicates.

Rejection based on Servick (5,450,979)

Claims 32-35,37,40,42-51 and 55 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Servick (5,450,979). The patent to Servick discloses a method for making a combination of a package and article that comprises constructing a package having the shape of a football and which is different from the article to be placed in it, the package comprises of totally separable parts (see the figures). Examples of articles that can be placed in the package include toys, wallet, keys, coins, candy bars, chips etc (see column 3, line 23 et seq).

Regarding claims 35,40,42,51 and 51 and their dependent claims, Servick discloses the method of using more than one combination of a package and article since the patent discloses the packing of different articles in the different packages.

Claims 26,38,41,54,56 and 58 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Servick (5,450,979). The package of Servick lacks the specific article recited in claim 26. Since Servick teaches the placing of different kinds of articles within the package, it would have been obvious to one skilled in the art to place any clothing including rain gear within the package. In fact the placement of any article in the package of Servick, including articles with openeable lips such as bags (claim 29), would have been obvious to one skilled in the art. The claims would have been obvious because the substitution of one known article for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention.

Claims 24,25,36,52,53 and 57 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Servick (5,450,979) in view of Gossard. The package of Servick lacks the shape of a golf ball. The patent to Gossard shows packages of various shaped in the form of baseball, football, basketball and soccer ball. It would have been obvious to one skilled in the art to shape the packages of Servick in any desired shape including balls as shown by Gossard. The modification of Servick by forming the package with a ball shape as shown by Gossard would have been obvious because the use of one known and equivalent package shape for another would have yielded predictable and expected results to one of ordinary skill in the art at the time of the invention. Regarding claim 18, Kaufman discloses in column5, line 43 et seq that combining of two packages in one outer package.

ADDITIONAL REFERENCES CITED

The cited prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

/John Sipos/
Primary Examiner
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